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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,944	03/15/2004	John T. Strom	044182 308760	2939
7590 Pillsbury Winthrop LLP Intellectual Property Group Suite 200 11682 El Camino Real. San Diego, CA 92130-2092			EXAMINER PATEL, PARESH H	
			ART UNIT 2829	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/801,944

Applicant(s)

STROM ET AL.

Examiner

Paresh Patel

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-13, 15, 16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 5, 8, 14, 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: 02/07
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Prosecution on the merits of this application is reopened on claims 1-20 considered unpatentable for the reasons indicated below:

To add the 35 U.S.C. 101 rejection. The prior art rejection is being maintained.

The Appellant may with modification to address the 101 issues, reinstate the appeal brief.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 9 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims 1, 9 and 18 are directed to a judicial exception e.g. abstract idea; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (see OG Notice 22 November 2005 and MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely calculating the probe float as claimed is not appear to be sufficient to constitute a tangible result, since the outcome of the calculating step has not been used in a disclosed practical application nor claimed as made available in such a manner that its usefulness in a disclosed practical application can be realized. As such, the subject matter of claims is not patent eligible.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 7, 9-13, 15, 16, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Harris.

With regard to claims 1 and 9, Harris teaches a method of calculating and measuring a probe float comprising: acquiring a free-hanging planarity measurement, obtaining a first electrical contact planarity measurement, and calculating probe float using results of the acquiring and obtaining (abstract).

With regard to claims 2 and 10, Harris teaches the calculating comprising computing a difference between results of the obtaining and acquiring (col. 5, lines 38-42).

With regard to claims 3 and 12, Harris teaches acquiring a reference planarity measurement, providing relative translation between a contact surface and a probe card, identifying new free-hanging probes responsive to the providing, assigning a planarity value to newly identified free-hanging probes, and selectively repeating the providing, identifying, and assigning (col. 5, lines 1-20 & col. 6, lines 42-56).

With regard to claims 4 and 13, Harris teaches selectively iterating the providing, identifying, and assigning until a planarity value has been assigned to every probe (col. 11, lines 42-46).

With regard to claims 6, 7, 15, and 16, Harris teaches acquiring a reference planarity and identifying new free-hanging probes measurement comprises utilizing the optical system (col. 6, lines 32-37).

With regard to claim 11, Harris teaches repeating the acquiring, obtaining, and calculating for each probe (fig. 3).

With regard to claim 18, Harris teaches a computer readable medium with data and instructions that acquires a free-hanging measurement, obtains a first electrical contact planarity measurement, and calculates probe float using the free-hanging planarity measurement and the first electrical contact planarity measurement (abstract & col. 11, lines 32-40).

With regard to claim 19, Harris teaches the instructions further comprising computing a difference between results of the obtaining and acquiring (col. 5, lines 38-42).

With regard to claim 20, Harris teaches the instructions further comprising repeating the acquiring, obtaining, and calculating for each probe (fig. 3).

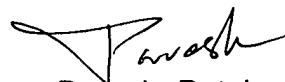
***Allowable Subject Matter***

3. Claims 5, 8, 14, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on 571-272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paresh Patel  
Primary Examiner  
Art Unit 2829

*Feb. 16, 2007*  
~~March 09, 2006~~